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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,274	12/16/1999	ITSUO WATANABE	7426-0067	5733

7590 06/18/2002

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EXAMINER

AYLWARD, DAVID E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/18/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-13

Office Action Summary

Application No.

09/402 274

Applicant(s)

Watanabe et al.

Examiner

Ay/ward

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on Feb, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 2, 8, 9, 19-45 is/are pending in the application.
- Of the above claim(s) 8, 9, 19-23, 25-27, 34, 35, 37, 39-45 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 2, 24, 28-33, 36, 38 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 10, 13 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

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1. Applicant's election with traverse of Group I, claims 1, 2, 24, 28-34, 36 and 38 in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the inventions of the present application are so inter-related no additional search would be required to examine all claims. This is not found persuasive because many of the inventions would require separate searches for example Group I would be classified in a class different from Group II because one invention contains a hydroxyl containing resin and the other does not.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 34 should obviously have been put in Group II since it depends directly from claim 8. Thus, claims belonging to Group I and examined in this Action are claims 1, 2, 24, 28-33, 36 and 38.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 24, 28-33 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In claim 1, it is confusing to claim a circuit connecting material which "electrically connects the electrodes" but is composed essentially of insulating components. Claims 2, 24 and 28-³³~~34~~ since they depend from claim 1 incorporate these confusing elements without correcting them.

6. Claim 38 is indefinite because it depends from a cancelled claim.

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7. Reference: "GG" is added to the 1449 form received in July of 2000 because an abstract for JP 50126054 was included with this form.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 28 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 50126054, JP'054.

10. The Abstract of JP '054 received with the IDS of July, 2000 is used as a guide to its content. It shows JP '054 teaches a composition of a hydroxy containing resin with average molecular weight of 10,000 or less along with the other components of instant claim 1. It would have been obvious to add conductive particles to the adhesive of JP'054 to render it conductive, because it has been held it is obvious to add a component for its art recognized effect, e.g. rendering a composition conductive.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

12. a. the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

13. Claims 1, 24, 28, 29, 34 and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 11279511, JP '511.

14. The Abstract of JP '511 is used as a guide to its contents. JP '511 is an intervening reference and the Abstract shows all the components of the instant claims.

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15. Claims 1, 24, 28, 29, 34 and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 11279513, JP '513.

16. JP '513 is an intervening , the Abstract, which shows JP '513 teaches all the components of the instant claims, is used as a guide to the contents of the reference.

17. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Aylward whose telephone number is (703) 308-2372. The examiner can normally be reached on Monday-Friday from 7:30 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Aylward/dh
June 4, 2002



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700